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Docket No.: 215095US0PCT

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

RE: Application Serial No.: 09/926,385
Applicants: Takashi TOJO, et al.
Filing Date: October 24, 2001
For: CYCLIC HEXAPEPTIDES HAVING ANTIBIOTIC ACTIVITY
Group Art Unit: 1653
Examiner: DAVID LUKTON

SIR:

Attached hereto for filing are the following papers:

Response to Restriction Requirement

Our check in the amount of **$0.00** is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

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DOCKET NO: 215095US0PCT

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF	:	
TAKASHI TOJO, ET AL.	:	EXAMINER: LUKTON, DAVID
SERIAL NO: 09/926,385	:	
FILED: OCTOBER 24, 2001	:	GROUP ART UNIT: 1653
FOR: CYCLIC HEXAPEPTIDES HAVING ANTIBIOTIC ACTIVITY	:	

RESPONSE TO RESTRICTION REQUIREMENT

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

In response to the Restriction Requirement mailed March 5, 2004, Applicants elect, with traverse, Group I, Claims 1-7, 9 and 11, drawn to compounds for examination. In addition, Applicants elect the single disclosed species, Example 184, for examination.

REMARKS

The Examiner is requiring restriction of the above-identified application as follows:

Group I: Claims 1-7, 9 and 11, drawn to compounds;

Group II: Claim 8, drawn to a method of making compounds; and

Group III: Claim 12, drawn to a method of using compounds.

Applicants have elected Group I, Claims 1-7, 9 and 11, drawn to compounds, with traverse.

The Examiner is also requiring election of an ultimate, single disclosed species within the chosen group.

Applicants have provisionally elected, for search purposes only, Example 184 for examination.

Restriction is only proper if the claims of the restricted groups are independent or patentably distinct and there would be a serious burden placed on the examiner if restriction is not required. (M.P.E.P. § 803). The burden of proof is on the examiner to provide reasons and/or examples, to support any conclusion in regard to patentable distinctness (M.P.E.P. § 803). Applicants respectfully traverse the restriction requirement on the grounds that the Examiner has not carried the burden of providing any reason and/or examples to support any conclusion that the claims of the restricted groups are patentably distinct.

The Examiner has categorized the relationships between Groups I and II as product and process of making product. Patentable distinctness may be shown if either or both of the following can be shown: (1) that the process as claimed is not an obvious process of making the product and the process as claimed can be used to make other and different products, or that the product as claimed can be made by another and materially different process (M.P.E.P. § 806.05(f)). However, the Examiner has not provided an example or reason to support the criteria required under § 806.05(f)). Therefore, the examiner's reasoning is nearly a restatement of the examiner's conclusion that the two groups are patentably distinct. As the examiner has provided no reasons in support of this belief, the examiner has not met the burden placed upon him, and accordingly, the restriction is believed to be improper and should be withdrawn.

The examiner as categorized the relationships between Groups I and III as product and process of use. Patentable distinctness may be shown if either or both of the following can be shown: (1) that the process of using as claimed can be practiced with another materially different product or (2) that the product as claimed can be used in a materially different process (M.P.E.P. § 806.05(h)). However, the examiner has not provided an

example or reason to support the criteria required under § 806.05(h). Therefore, the Examiner's reasoning is nearly a restatement of the examiner's conclusion that the two groups are patentably distinct. As the examiner has provided no reasons in support of his belief the Examiner has not met the burden placed upon him, and accordingly, the restriction is believed to be improper and should be withdrawn.

Applicants submit this application is now in condition for examination on the merits and early notification of such action is earnestly solicited.

Respectfully submitted,

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